

Docket No. 98-11CIP1RCE
PATENT

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REMARKS

Claims 1, 3-9, 12-14, 19, 23-24, 27, 29, 37, 39-45, 48-50, 55, 59-60, 63, 65, 92, 94-95, 97, and 99-100 were pending. Claims 1, 3-9, 12-14, 37, 39-45, and 48-50 are cancelled without prejudice by this Amendment. No new matter has been added. The applicant respectfully requests reconsideration of the pending claims in light of the above amendments and the following remarks

1. Interview Summary

The applicant thanks Examiners Jason Sims and Carolyn Smith for extending the courtesy of a telephonic interview on October 5, 2006 to address the rejections under section 112. During the interview Tim Porter, the applicant's undersigned representative, suggested that the pending claim language itself addressed the alleged indefiniteness identified in the Office action – specifically, that the statement that the chemicals or mixtures of chemicals to be assigned to a given cell are “determined by the one or more sources” is expressly modified by the immediately following phrase “associated with the area or areas that include the cell”, which establishes that it is the association between sources and areas that determines which chemicals or mixtures are assigned to which cells, and not merely the sources or even the solving of equations that does so. This is discussed in more detail below.

2. Rejections under Section 112

Claims 19, 23-24, 27, and 29 were rejected under 35 U.S.C. § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 23-24, 27, 29, 59-60, 63, 65, 92, 94-95, 97 and 99-100 were rejected as being dependent from a rejected claim. In particular, the Office action states that claims 19 and 55 are indefinite in their statement that “the chemicals to be assigned to the given cell are ‘determined by the one or more sources’”. Based on this statement, the applicant assumes that the rejection was intended to encompass claim 55 as well. As noted above, the applicant respectfully disagrees with the rejection.

Docket No. 98-11CIP1RCE
PATENT

Claim 19 is directed to a computer-implemented method for generating a library design for a combinatorial library of materials. In relevant part, the claim includes the steps of "receiving user input associating each of the one or more sources with one or more of the destination areas," "receiving user input specifying a plurality of equations and associating each of the plurality of equations with one or more of the one or more destination areas," and "solving the plurality of equations to calculate one or more amounts of one or more first chemicals or mixtures of chemicals represented by the one or more defined sources to be assigned to one or more cells in the one or more arrangements represented by the one or more defined destinations." According to the claim, the amounts of chemicals or mixtures to be assigned to a given cell are calculated according to a set of equations associated with the area or areas that include the cell, while the identity of the chemicals or mixtures to be assigned to the given cell is "determined by the one or more sources *associated with the area or areas that include the cell*" (emphasis added).

The applicant submits that the italicized passage makes it clear that it is not merely the sources that determine which chemicals or mixtures are assigned to which cells in the claimed method. Rather, the chemicals or mixtures that will be assigned to a given cell are determined based on which sources have been associated with the destination area or areas that include the cell.

This is described further in the specification at, for example, page 20, lines 10-20, where it is stated that the user "may assign a component (*i.e.*, a source or sources, including a chemical or chemicals) to a header", which "causes design module 130 to assign the component represented by source icon 731 to all cells assigned to header 720 for use in equations governing those cells" (*see* p. 20, lines 10-11, 13-15). The specification further states that "the user may assign components (sources or chemicals) to one or more individual cells or groups of cells by dragging the selected component and dropping it into the desired cell or cells" (*id.*, lines 15-17).

The applicant submits that one skilled in the art would understand that the chemicals or mixtures to be assigned to a given cell in claim 19 are those that are represented by the sources that were associated with the given cell in the first "receiving user input" step, and that the claim is therefore not indefinite under Section 112. The

Docket No. 98-11CIPIRCE
PATENT

applicant therefore respectfully requests that the rejection of claim 19 under Section 112, second paragraph, be withdrawn.

Claim 55 is a computer program product claim that includes limitations that are directly analogous to those of claim 19. Claims 23-24, 27, 29, 59-60, 63, 65, 92, 94-95, 97, and 99-100 are dependent claims based directly or indirectly on claims 19 or 55. The applicant submits that these claims are not indefinite for the reasons discussed above in the context of claim 19, and requests that the rejection of these claims under section 112 be withdrawn.

3. Rejections under Section 102

Claims 1, 3-7, 12-14, 37, 39-43, and 48-50 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,165,778 ("Kedar"). Claims 1, 3-7, 12-14, 37, 39-43, and 48-50 have been cancelled without prejudice by this Amendment, rendering the rejection moot. The applicant therefore respectfully requests that the rejection under Section 102(e) be withdrawn.

4. Rejections under Section 103

Claims 1, 3-9, and 12-14 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,044,212 ("Flavin") in view of U.S. Patent No. 6,044,617 ("Schultz") and U.S. Patent No. 6,295,514 ("Agrafiotis"). Claims 1, 3-9, and 12-14 have been cancelled without prejudice by this Amendment, rendering the rejection moot. The applicant therefore respectfully requests that the rejection under Section 103(a) be withdrawn.

5. Rejections for Obviousness-Type Double Patenting

Claims 1, 3-9, 12-14, 19, 21, 23, 29, 37, 39-45, 48-50, 55, 91, 97, and 99-100 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-7, 9-12, 27-31, 33-36, 55-63, 65-74 and 76-104 of copending Application No. 09/174,856. Claims 1, 3-9, 12-14, 37, 39-45, and 48-50 are cancelled without prejudice by this Amendment, rendering the rejection moot as to these claims. As for the remaining claims, a terminal disclaimer is being submitted with this

Docket No. 98-11CIP1RCE
PATENT

Amendment. The applicant therefore requests that the rejection for obviousness-type double patenting be withdrawn.

6. Conclusion

The applicant submits that all remaining claims are now in condition for allowance. No fees are believed to be due at this time. Please charge any fees or credits to Deposit Account 50-0496.

Respectfully submitted,

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